

REMARKS

Claims 1-42 are currently pending in the application. The Examiner has rejected Claims 1-22 and 35-42 under 35 U.S.C. § 101 as directed to nonstatutory subject matter. In addition, the Examiner has rejected Claims 1-16 and 23-42 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,591,256 to Friedman. Finally, the Examiner has rejected Claims 11-14 and 17-22 under 35 U.S.C. § 103(a) as unpatentable over Friedman. Applicant respectfully traverses all such rejections as discussed below. Applicant also respectfully traverses on the basis that the office action is not signed. Finally, Applicant respectfully traverses the Examiner's statements, amounting to rejections, that each of the articles *Business Insight* and *Expert Systems in Marketing* "could have been used for rejection, but to avoid duplicate rejection, it's cited here for applicant's awareness of well known problem solving techniques." (Office Action at 8) Applicant's traversal is based on the absence of explanation or even of any indication as to the statutory basis for rejection based on these references. No new matter has been added.

The claimed invention describes an apparatus and method of providing business solutions and services via an interactive communications medium, where such solutions and services are currently devised using consultants, accountants, and sales people. The claimed invention provides a method of providing business solutions over an interactive communications medium, which may be the world wide web portion of the Internet. (Figure 4) The method includes selectively providing metrics which are associated with a business problem and a specific industry and providing a business solution based on the selective metrics and responses to the selective metrics. (Figure 1) The metrics module 104 may include questions requiring a "yes or no" response or a response within a certain range, enabling the use of industry benchmarks to determinine whether a given range is acceptable or problematic. Alternatively, the metrics module 104 may solicit a more quantitative response. The metrics are preferably provided in a hierarchical tree format. (Figure 3) In addition, the claimed invention provides a method for providing

business solutions over an interactive communications medium. The method includes identifying a specific industry and providing at least one business measure associated with a particular financial aspect of the specific industry. (Figure 2) The method further includes providing a set of questions associated with problems of the specific industry, where the set of questions are related to each of the provided at least one business measure. Thus, the user response to the question presented by the metrics module 104 is used either to generate new pertinent questions or to map generic solutions provided by a functionality module 106. A functionality is a generalization as to what a solution may accomplish. A business solution is thus provided based on responses to the set of questions and the specific industry. Furthermore, the claimed invention provides a system for providing business solutions over an interactive communications medium. The system further includes a business solution module which provides business solutions based on responses to the selected questions stored in the business metrics module and the specific industry. Finally, the claimed invention provides a machine readable medium containing code for providing business solutions over an interactive communications medium. The code implements the steps of selectively providing metrics which are associated with a business problem and a specific industry and providing a business solution based on the selective metrics and responses to the selective metrics.

Rejection of Claims 1-22 and 35-42 Under 35 U.S.C. § 101

The Examiner rejected Claims 1-22 and 35-42 under 35 U.S.C. § 101 as directed towards nonstatutory subject matter. At the same time, however, the Examiner has rejected these claims under 35 U.S.C. §§ 102(a), 103(a) on the basis that the claims are anticipated by Friedman and/or are not patentable over Friedman. If, however, the claims were directed toward nonstatutory subject matter, it is impossible to understand how the substance of the claims could be reflected in Friedman, since that patent must be viewed as drawn to statutory subject matter as a result of the fact that it has issued. As a result, Applicant traverses the rejection of Claims 1-22 and 35-42 under 35 U.S.C. § 101 as inconsistent with the Examiner's rejection of the same claims under 35 U.S.C. §§ 102(a),

103(a).

Applicant also traverses the rejection of claims under 35 U.S.C. § 101 as based on an overly narrow interpretation of the statute which is contradicted by the statutory scheme as well as by cases cited by the Examiner in support of the rejection. The Examiner thus rejected Claims 1-22 on the basis that they are drawn to a “method” and that a “method” is not a “process” or any other type of subject matter specifically enumerated by 35 U.S.C. § 101 as patentable. Applicant traverses on the basis that the term “process” as used in 35 U.S.C. § 101 is specifically defined by 35 U.S.C. §100(b) as including a “method” such as the methods of the claimed invention. Similarly, the Examiner has rejected Claims 35-42 on the basis that “machine readable medium” is not a type of invention specifically enumerated by 35 U.S.C. § 101 as patentable. Applicant traverses on the basis (a) that the term “machine-readable medium” as used in Claims 35-42 is directed to a machine, composition of matter, or material and (b) that the term “process” as used in 35 U.S.C. § 101 to identify patentable subject matter is specifically defined by 35 U.S.C. §100(b) as including “a new use of a . . . machine, . . . composition of matter, or material.”

Claims 1-22 and 35-42 describe, among other things, business methods which are patentable under 35 U.S.C. § 101. “Since the 1952 Patent Act, business methods have been, and should have been, subject to the same legal requirements for patentability as applied to any other process or method.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998). Cases cited by the Examiner to support rejection do not support, and in fact contradict, rejection under 35 U.S.C. § 101. The Federal Circuit in *In re Alappat*, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994), for example, reversed a PTO finding of unpatentability under 35 U.S.C. § 101 and held the invention at issue to be patentable because it was directed to an apparatus and not to “a disembodied mathematical concept.” 31 U.S.P.Q.2d at 1557. The Court of Customs and Patent Appeals in *In re Waldbaum*, 173 U.S.P.Q. 430 (C.C.P.A. 1972), similarly reversed a rejection under 35 U.S.C. § 101, discarding various theories that had been advanced under 35 U.S.C. § 101 and holding that “[t]he language pertaining to the

new use of known processes, machines, etc. was not placed in section 100(b) to impose special standards for inventions pertaining to such uses but rather to dispel all doubt that these inventions are patentable and to place them under the ‘process’ category of 35 U.S.C. 101.” 173 U.S.P.Q. at 434. The Court of Customs and Patent Appeals in *In re Musgrave*, 167 U.S.P.Q. 280 (C.C.P.A. 1970), likewise reversed a rejection under 35 U.S.C. § 101 and held that the decision below had incorrectly applied a mental steps rejection even though the process claimed did not consist solely of mental steps. *See* 167 U.S.P.Q. at 289. Finally, the Court of Customs and Patent Appeals in *In re Johnston*, 183 U.S.P.Q. 172 (C.C.P.A. 1972), reversed a rejection under 35 U.S.C. § 101 on the basis that the claims at issue were patentable as apparatus claims under 35 U.S.C. § 101. *See* 183 U.S.P.Q. at 176-77. The rejection under 35 U.S.C. § 101 is thus traversed on the basis that it is contrary to legal authority and not supported by the legal authority cited by the Examiner. Additional traversals are as follows:

Claims 1-22. The Examiner rejected independent Claims 1 and 18 and dependent Claims 2-17 and 19-22 on the basis that steps related to the claimed “method of providing business solutions over an interactive communication medium” is not within the enumeration of patent subject matter under 35 U.S.C. § 101. Applicant respectfully traverses. Because the claimed “interactive communications medium” is clearly a machine system, the rejection is without justification and contrary to legal authority relied on by the Examiner in support of the rejection. For example, the Federal Circuit in *Alappat* held that because a claim “is directed to a ‘machine,’ which is one of the four categories of patentable subject matter enumerated in § 101, [the claim] appears on its face to be directed to § 101 subject matter.” 31 U.S.P.Q. at 1555. Similarly, the Court of Customs and Patent Appeals in *Johnston*, where methods claims were related to a record-keeping machine system, unambiguously held that “[r]ecord-keeping *machine* systems are clearly within the ‘technological arts’ . . . , and ‘claims defining them must be judged for patentability in light of the prior art.’ 183 U.S.P.Q. 176-77.

Claims 35-42. The Examiner rejected independent Claim 35 and dependent Claims 36-42 on the basis that steps related to the claimed “machine readable medium

containing code for providing business solutions over an interactive communication medium” is not within the enumeration of patent subject matter under 35 U.S.C. § 101. Applicant respectfully traverses. Claims 35-42 are directed to a claimed “machine readable medium” and a related claimed “interactive communication medium.” Such claims are directed to a patentable “process” as that term is used in 35 U.S.C. § 101. The term “process” is defined to include “a new use of a . . . machine, . . . composition of matter, or material.” 35 U.S.C. §100(b). The rejection of Claims 35-42 is also contrary to legal authority relied on by the Examiner for reasons already discussed above.

Claims 1-22 and 35-42 are directed toward subject matter which is patentable under 35 U.S.C. § 101 and should be allowed.

Rejection of Claims 1-16 and 23-42 Under 35 U.S.C. § 102(a)

The Examiner rejected Claims 1-16 and 23-42 under 35 U.S.C. § 102(a) on the basis that the claims are anticipated by Friedman. Applicant respectfully traverses. Unlike the claimed invention, Friedman describes a method for providing application software, in particular software that solves certain business problems by invoking solutions of generic mathematical problems which may be hidden from the user. Friedman describes a processor 10 with an attendant working and program memory 15, and a coupled communications module 20, all of which are arranged in a manner described by Friedman as “perfectly conventional in the web server art.” (Friedman, column 2, line 11) Coupled to the processor 10 may be: a generic mathematical solver store 30 to store software packages; a database 40 of explanation comments; a web pages memory 45; and an expert system 50. When the processor 20 is configured with a communications module 20 to form a web server that can be connected to the Internet, remote users can connect to the system by retrieving and displaying web pages. (Friedman, column 2, lines 8-22) Friedman describes the expert system 50 as “conventional except, of course, for the actual information it contains.” (Friedman, column 4, lines 52-53) Thus, the expert system 50 may be as simple as a table of key words or a more complicated system allowing for Boolean statements, etc. (Friedman, column 4, lines 58-61) The use of the metrics module 104 and functionality module 106

in the claimed invention is not equivalent to Friedman's invocation of generic mathematical problems.

Claims 1-16. Claims 1-16 are not anticipated by Friedman, and Friedman does not "disclose a method for providing business solutions over an interactive communications medium, comprising the steps of: (a) selectively providing metrics (questions) which are associated with a business problem and a specific industry; and (b) providing a business solution based on the selective metrics and responses to the selective metrics," as contended by the Examiner. Instead, where Friedman discloses methods for providing access to software, independent Claim 1 and dependent Claims 2-16 (and the claimed invention generally) concern the provision of business solutions. The Examiner incorrectly equates the limitation of Claim 6, "wherein the specific business solution is transparent to a user," with matters "inherently included" in Friedman. The "clear and simple module of information" discussed by Friedman is described in juxtaposition to *ambiguity* (Friedman, column 3, line 32) and not in juxtaposition to *transparency* or *opacity* of a user's visibility into a process. The Examiner likewise incorrectly equates the "ranking rules" of Claim 7 with Figures 5 and 7 of Friedman. Where Claim 7 involves ranking a general business solution and a specific business solution in order of business priority, the passage from Friedman cited by the Examiner (Friedman, column 5, lines 45-65) concerns cost minimization. Similarly, Claims 8-10 are not anticipated by Figures 2 and 3 of Friedman, because Friedman deals with specific mathematical problems, such as optimization, not discussed by Claims 8-10. Likewise, Claims 11-14 are not subsumed by Friedman's discussion of an "expert system" or "sequential policy problems" inasmuch as those terms do not appear in Claims 11-14, are not defined by Friedman in such a way as to cover Claims 8-10, and are not understood by those with ordinary skill in the art as having meanings that cover Claims 8-10. With regard to Claim 15, the Examiner states without explanation that the claim "is shown" by Figures 5-7 of Friedman, even though the figures show how data is to be displayed on a computer screen and there is no mention of "providing quantitative metrics and selective metrics and the response," as in Claim 15.

Finally, with regard to Claim 16, the Examiner states without explanation that the claim “is shown” in Friedman by the “cost table complete” at Figure 7 and by the discussion at column 6, lines 15-30 and 55-62. To the contrary, however, the term “cost table complete” does not appear in Claim 16, is not defined by Friedman in such a way as to cover Claim 16, and is not understood by those with ordinary skill in the art as having a meaning that covers Claim 16; furthermore, the discussion at column 6, lines 15-30 and 55-62 makes no mention of “providing a financial analysis of the business solution based on at least one quantitative response to the quantitative metrics,” as in Claim 16, but instead relates to minimizing costs and calculating transportation costs and mortgages.

Claims 23-28. The Examiner has rejected Claim 23 for the same reasons Claim 1 has been rejected, and the rejection of Claim 23 is therefore traversed on the same basis as the rejection of Claim 1. The Examiner has rejected Claim 24 for the same reasons Claim 2 has been rejected, and the rejection of Claim 24 is therefore traversed on the same basis as the rejection of Claim 2. The Examiner has rejected Claims 25-27 for the same reasons Claim 5 has been rejected, and the rejection of Claims 25-27 is therefore traversed on the same basis as the rejection of Claim 5. The Examiner has rejected Claim 28 for the same reasons Claim 16 has been rejected, and the rejection of Claim 28 is therefore traversed on the same basis as the rejection of Claim 16.

Claims 29-34. The Examiner has rejected Claim 29 for the same reasons Claims 1-2 have been rejected, and the rejection of Claim 29 is therefore traversed on the same basis as the rejection of Claims 1-2. The Examiner has rejected Claim 30 for the same reasons Claim 15 has been rejected, and the rejection of Claim 30 is therefore traversed on the same basis as the rejection of Claim 15. The Examiner has rejected Claim 31 for the same reasons Claim 16 has been rejected, and the rejection of Claim 31 is therefore traversed on the same basis as the rejection of Claim 16. With regard to Claim 32, the Examiner states without explanation that the claim “is taught” by Friedman at column 4, lines 45-65 and at column 3, lines 5-20, even though the passages from Friedman cited by the Examiner discuss an “expert system” which “is conventional except of course for the actual information in contains” and a group of business problems

which “can be solved by mapping the business problem to one or more generic mathematical problems,” while making no mention of “a rules module which generates rules, the rules being used to determine the business solution based on the responses and pertinent questions to provide to a user based on the responses,” as in Claim 32. The Examiner has rejected Claim 33 for the same reasons Claim 15 has been rejected, and the rejection of Claim 33 is therefore traversed on the same basis as the rejection of Claim 15. Finally, with regard to Claim 34, the Examiner states without explanation that the claim “is shown” in Friedman at Figure 1 even though Friedman does not show “the business driver module, the business metrics module and the business solution module are accessed by one of a web page resident on a server, a telephone and a personal digital assistant,” as in Claim 34.

Claims 35-42. The Examiner has rejected Claims 35-42 for the same reasons Claims 1, 2, 4, 7, 8, 12, 15, and 16 have been rejected, and the rejection of Claims 35-42 is therefore traversed on the same basis as the rejection of Claims 1, 2, 4, 7, 8, 12, 15, and 16.

Claims 1-16 and 23-42 are, therefore, not anticipated by Friedman and should be allowed.

Rejection of Claims 11-14 and 17-22 Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 11-14 and 17-22 under 35 U.S.C. § 103(a) on the basis that the claims are not patentable over Friedman. Applicant respectfully traverses as explained in paragraphs below. In addition, Applicant traverses the Examiner’s reliance on *In re Aller*, 105 U.S.P.Q. 233 (C.C.P.A. 1955) as an alternative basis for rejection under 35 U.S.C. § 103(a). *Aller* addressed the question whether routine experimental improvements in a chemical process were separately patentable over the original process, which is not analogous to the present situation. Because the claimed invention does not result from routine experimentation on the invention of Friedman, the invocation of *Aller* is misplaced. Applicant also specifically traverses the Examiner’s unsupported assertion that any claims of the claimed invention amount to routine experimental improvements over a previous invention. Such assertion constitutes impermissible hindsight and an

improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. (*Aller* does not constitute a reference as to this matter, because it is necessary to find that the invention amounts to routine experimental improvements before *Aller* can be applied.) See MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970)). Additional traversals are as follows:

Claims 11-14. The Examiner has rejected Claims 11-14 as unpatentable over Friedman on the basis that Friedman discusses optimization. While Friedman describes uses of an optimization node (Friedman, Figures 2 and 3 and column 5, line 10), the disclosure of optimization does not address business problems as claimed in Claims 11-14 and 17-22. Optimization, a mathematical technique for finding a maximum or minimum value of a function of several variables subject to a set of constraints, requires significantly more data than could reasonably be supplied according to the user-input methodology envisioned by the claimed invention. A person of ordinary skill in the art would recognize that the data-intensiveness of optimization requires the inputting of large amounts of data, making it unsuited for use where data is to be entered over an interactive communications medium, as in the claimed invention.

Claims 17-22. The Examiner has rejected Claim 17 as unpatentable over Friedman on the basis that Friedman “teaches results of financial analysis such as maximum profits, minimum cost, cost table complete, assignment cost, forecasting, mortgage calculation, etc.” The categories of mathematical calculations identified by the Examiner in rejecting Claim 17, however, are not suited to use in the claimed invention, are not discussed in the claims, and are not comparable to what it discussed in the claims. It would thus not be obvious to one of ordinary skill in the art to arrive at the Claim 17 in view of Friedman. The Examiner has rejected Claim 18 for the same reasons Claims 1 and 16-17 have been rejected, and the rejection of Claim 18 is therefore traversed on the same basis as the rejection of Claims 1 and 16-17. The Examiner has rejected Claim 19 for the same reasons Claim 5 has been rejected, and the rejection of Claim 19 is therefore traversed on the same basis as the rejection of Claim 5. The Examiner has rejected

Claim 20 for the same reasons Claim 7 has been rejected, and the rejection of Claim 20 is therefore traversed on the same basis as the rejection of Claim 7. The Examiner has rejected Claim 21 for the same reasons Claims 11-12 have been rejected, and the rejection of Claim 21 is therefore traversed on the same basis as the rejection of Claim 11-12. The Examiner has rejected Claim 22 for the same reasons Claim 15-16 have been rejected, and the rejection of Claim 22 is therefore traversed on the same basis as the rejection of Claim 15-16.

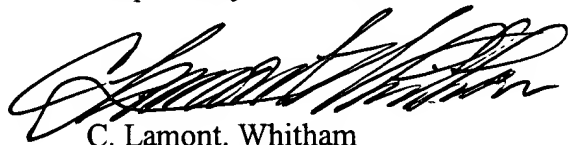
For these reasons, Claims 11-14 and 17-22 are patentable over Friedman and should be allowed.

Conclusion

In view of the foregoing, Applicant submits that all of the claims are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,



C. Lamont. Whitham

Registration No. 22,424

Customer number: 30743

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190
Tel. (703) 787-9400
Fax. (703) 787-7557